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299 East Sixth Street
CINCINNATI, OH 45202

EXAMINER

ARNOLD, ERNST V

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/687,845
Filing Date: October 17, 2003
Appellant(s): PESCE ET AL.

Jason J. Camp
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/15/08 appealing from the Office action mailed July 18, 2008.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6506958	Williams	01-2003
4583980	Schneider	04-1986
5451404	Furman	09-1995

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 10-17, 19 and 20 remain/are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (US 6,506,958) in view of Schneider et al. (US 4,583,980) and Furman (US 5,451,404).

Applicant claims a hygienic article comprising a composition comprising a cooling agent with an ester derivative.

Determination of the scope and content of the prior art

(MPEP 2141.01)

Williams teaches a signal tampon with an indicator designed to provide a sensory signal to the user (Abstract). The sensory signal can be a cold sensation produced by a cold sensation material such as menthyl lactate (a cyclohexyl structure), menthol, ethanol or combinations thereof (Column 4, lines 1-10 and claim 16). It is the Examiner's position that the teaching of Williams suggests combining a first cooling agent, menthol, with a second cooling agent such as menthyl lactate.

Schneider teaches a sanitary hygiene product having odor preventing properties that contains triethyl citrate (claims 1-4; column 3, lines 29-49 and column 4, lines 1-15). Schneider teaches that the triethyl citrate can be mixed with perfume oils (column 3, lines 35-49). Schneider teaches that triethyl citrate has the strongest odor preventing effect and best suitability for practical application (column 3, lines 2-5).

Furman teaches cooling compositions comprising a ketal and a secondary coolant, which may be menthol, carboxamides or mixtures thereof (Abstract; column 2, line 28 through column 5, line 53 and claims 1-10). The compositions can be applied to the body (column 5, line 57 and include toilet articles (column 6, lines 11-12 and claim 8). The composition can be formulated into a carrier such as solids, liquids, emulsions, foams and gels (column 6, lines 19-32).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

1. The difference between the instant application and that of Williams is that Williams do not expressly teach the signal tampon with an ester derivative or other cooling agents such as

ketals and carboxamides. This deficiency in Williams is cured by the teachings of Schnieder and Furman.

2. The difference between the instant application and that of Williams is that Williams do not expressly teach the signal tampon with a first cooling agent and a second cooling agent in a weight ratio of 1/1 to 1/100.

3. The difference between the instant application and that of Williams is that Williams do not expressly teach the signal tampon wherein the cooling agent or a mixture thereof is present at a level of about 0.1% to about 99.9% and wherein the ester derivative or a mixture thereof is present at a level of from 99.9% to 0.1% by weight of the total composition.

4. The difference between the instant application and that of Williams is that Williams do not expressly teach the article wherein the composition is suitable for topical application to the external surface of a mammal in the form of a cream, lotion, emulsion, dispersion, gel, foam, oil, ointment or powder.

Finding of prima facie obviousness

Rational and Motivation (MPEP 2142-2143)

1. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to add an ester of citric acid, such as triethyl citrate, as suggested by Schnieder, or other cooling agents as suggested by Furman, to the hygienic article, tampon, of Williams and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because Schneider teaches that triethyl citrate is the best suitable odor preventing agent for this application. In

addition: "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). Furthermore, Furman establishes a wide variety of other cooling agents which could be utilized in the tampon of Williams.

2. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to add a first cooling agent and a second cooling agent in a weight ratio of 1/1 to 1/100 to the composition of Williams and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because Williams suggests combining cooling agents and it is merely routine optimization for one of ordinary skill in the art to arrive at the ratio of 1/1 to 1/100 by weight of the cooling agents.

3. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to add the cooling agent or a mixture thereof at a level of about 0.1% to about 99.9% and wherein the ester derivative or a mixture thereof is at a level of from 99.9% to 0.1% by weight of the total composition in the composition of Williams and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because Williams and Schneider provide the ingredients and it is merely routine optimization by one of ordinary skill in the art to arrive at the instantly claimed amounts. In fact Schneider provides guidance on how to apply the triethyl citrate in column 3, lines 12-34).

4. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to make the article of Williams wherein the composition is suitable for topical application to the external surface of a mammal in the form of a cream, lotion, emulsion, dispersion, gel, foam, oil, ointment or powder.

One of ordinary skill in the art would have been motivated to do this because Williams teaches that the indicator can be in a hydrogel, which is a type of gel (Column 3, lines 51-52).

Summary: The art teaches the use of triethyl citrate and cooling agents in sanitary hygienic articles. It is merely ordinary innovation to combine triethyl citrate and a cooling agent into a hygienic article. The expected result remains a signal tampon. From recent case law: “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”

In light of the forgoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible

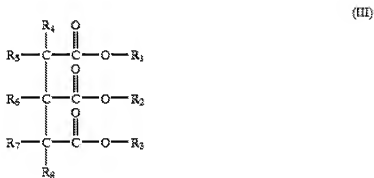
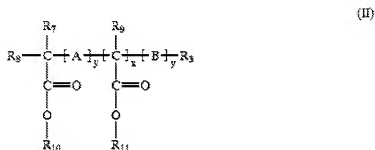
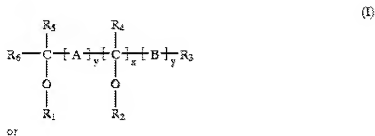
harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,972,010. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of the instant application is embraced by the claimed subject matter in the patent.

Claim 1 of US 6,972,010 is drawn to an absorbent article comprising an agent able to convey a perception to the wearer and a delivery system for containing and delivering the agent to the skin. Claim 1 of US 6,972,010 also recites wherein the delivery system comprises an alcohol or ester derivative of the following formulae:



Thus, the instant ester derivatives are fairly taught in US 6,972,010. US 6,972,010 does not expressly claim the article and agent in the claim language. The Examiner notes that: MPEP § 804 (II) states, "When considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. *General Foods Corp. v. Studiengesellschaft*

Kohle mbH, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992). This does not mean that one is precluded from all use of the patent disclosure.” (*emphasis added*). “Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970).”

Therefore, the Examiner looked to the specification for guidance on the type of agent and type of article. The article is described as being panty liners, for example, with topsheets and backsheets fully discussed (Column 25, line 1 through column 33, line 57). The agent is disclosed as being derivatives of ketals, carboxamides, cyclohexanol, cyclohexyl as well as a number of oils such as peppermint oil that can convey a perception, freshness sensation, to the wearer (Column 7, line 13 and 46 through column 14, line 60). One of ordinary skill in the art would have recognized the obvious variation of the instant invention over US 6,972,010 due to the overlap in claimed subject matter as described above.

II. Claims 10-17 and 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-6 and 8-13 of copending Application No. 11/106,402. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter is embraced by the subject matter of the copending application. The copending application claims an absorbent article, such as a panty liner, comprising an agent able to convey a perception to the wearer wherein the agent is a cooling agent selected from the group consisting of ketals, carboxamides, cyclohexyl derivatives, etc....(Claims 2-5). The article comprises a delivery system which is an emollient containing

composition comprises from about 0.1% to about 99.9% by weight of the agent and from about 99.1% to about 0.1% by weight of the emollient and the delivery system comprises triethyl citrate (claims 8-11). The article comprises a topsheet (claims 12-13). The article comprises menthol as a first cooling agent in combination with a second cooling agent (Claim 6). One of ordinary skill in the art would have recognized the obvious variation of the instant invention over the copending claims due to the overlap in subject matter as described above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

(10) Response to Argument

Appellant asserts there is no motivation to combine the fast acting signal tampon of Williams with the long lasting odor control teachings of Schneider because: “the utility for the references are at opposite ends of the spectrum in terms of the length of time over which each invention performs.” Respectfully, the Examiner cannot agree. The thrust of both prior art references is towards signal tampons of Williams and sanitary hygiene products, which include tampons (column 2, line 17), of Schneider. It is the Examiner’s position that it is common sense that the tampons are left in place until they are full and therefore the period of usage is the same for both Williams and Schneider.

Appellant asserts that: “If the teaching of Schneider et al. is applied to the tampon of Williams, the signal from the tampon in Williams would be dampened.” Thus, the modifying Williams with Schneider would render Williams unsatisfactory for its intended purpose and

change its principle of operation. This is an opinion without proof. There is nothing of record which would suggest such an effect. On the contrary, the expected result is a odorless signal tampon and there has been no showing to disprove this.

In conclusion, all Appellant has done is assemble known elements in the art into one composition. The mere combination of a number of known elements which, in combination, perform or produce no new or different function or operation than that theretofore performed or produced by them is not patentable. Appellant has added nothing to the total stock of knowledge, but has merely brought together segments of prior art and claims them in congregation as a monopoly. (*A. & P. TEA CO. v. SUPERMARKET CORP.*, 340 U.S. 147 (1950) 340 U.S. 147). (See also: *ANDERSON'S-BLACK ROCK, INC., Petitioner, v. PAVEMENT SALVAGE CO.*, U.S.P.Q. 673, 396 U.S. 57, 90 S.Ct. 305, 24 L.Ed.2d 258, 163). No unexpected results have been presented and synergy has not been argued.

Appellant's arguments are not persuasive and the rejection is maintained.

With respect to the double patenting rejections, Appellant has agreed to submit terminal disclaimers upon indication of allowable subject matter. Until such a time, the claims remain rejected.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Ernst V Arnold/

Examiner, Art Unit 1616

Conferees:

1. /Johann R. Richter/

Supervisory Patent Examiner, Art Unit 1616

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Supervisory Patent Examiner, Art Unit 1617